

### **REMARKS**

This responds to the Office Action mailed on April 23, 2007.

Claims 1, 8, and 15 are amended; as a result, claims 1-21 are now pending in this application.

#### **Objections to the Specification**

The informalities noted by the Examiner on page 2 of the Office Action have been corrected as required.

#### **§112 Rejection of the Claims**

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness with respect to the term “operating environment” in line 4. Applicants have amended claim 8 to clarify the claim. Therefore, Applicants respectfully request that rejection to claim 8 under 35 U.S.C. § 112, second paragraph, be removed and the claim be allowed.

#### **§103 Rejection of the Claims**

Claims 1, 2, 4-7, 15, 16 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemirovsky et al. (US 6,389,449) in view of Ackerman et al. (US 5,606,696).

Claims 3, 8-14 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemirovsky in view of Ackerman as applied to claims 1, 2, and 15 above, and further in view of Summer, Jr. et al. (US 4,414,624).

#### ***I) The Applicable Law***

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the

claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria should be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

A showing of “teaching, suggestion, or motivation” to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). *KSR International Co.*, p. 14, line 24 through p. 15, line 8. The court in *KSR* made it clear, however, that the “teaching, suggestion, or motivation” (TSM) test is only one tool that can be used to determine obviousness, noting that the Examiner or court simply has to “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* p. 14, lines 5-17. The court in *KSR* further noted that “to facilitate review, this analysis [supporting a rejection under 35 U.S.C. § 103(a)] should be made explicit.” *Id.*

Specifically, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *See KSR Int’l Co.*, p. 14, citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910

F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Furthermore, the Court in *KSR* reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

**2) Application of § 103 to rejected claims - Combining the References Does Not Supply All Claimed Elements:**

**Claims 1, 8, and 15**

Amended independent claims 1, 8, and 15 require, “if the first stream entering the kernel mode must block, then blocking the execution of the other streams of the plurality of streams.” The Office Action admits that neither Nemirovsky nor Summer discloses “entering a kernel mode by a first stream of the plurality of streams upon the occurrence of a context shifting event” (Office Action, paragraph 9, page 4; and paragraph 29, page 10). Applicant agrees. The problem offered by the Office, that Nemirovsky and Summer do not disclose, entering a kernel by a first stream, requires the Office to look to Ackerman.

Ackerman states that, “the exceptions always force a transition to the kernel mode no matter what mode the processor was in at the time the exception occurred.” (col. 13, lines 10-12). As stated in the Office, Ackerman only provides for “[an] exception handler [that] stores an alternate indication in the processor’s machine state register, that the floating point context is available for the thread.” (col. 6, lines 57-59). Moreover, as cited by Office Action, Summer

discloses, “the concept involves partitioning the trainer program into modules and dedicating the processing of each module to a separate microcomputer.” (col. 2, lines 10-13).

Contrary to the assertions made by the Office, none of the references considered by the Examiner, either alone or in combination provide a method, apparatus or system wherein “**if the first stream entering the kernel mode must block, then blocking the execution of the other streams of the plurality of streams**”, as claimed by the Applicants in each of amended independent claims 1, 8, and 15. That is, the deficiency of Nemirovsky is not remedied by adding Ackerman and Summer. Hence, the prior art reference (or references when combined) does not teach or suggest all the elements of claims 1, 8, and 15. Therefore, the current Office Action has failed to meet the burden under 35 U.S.C. § 103(a) to establish a prima facie case of obviousness as required by the MPEP and *In re Fine*.

Furthermore, it is respectfully noted that if an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is also nonobvious. See M.P.E.P. § 2143.03. Thus, the dependent claims are also not obvious, and the rejection of claims 2-7, 9-14, and 16-21 under 35 U.S.C. § 103(a) is improper. Reconsideration and withdrawal of the rejections under 35 USC § 103(a) is respectfully requested.

**RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6909 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date

July 23, 2007

By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23 day of July 2007.

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